

REMARKS

The Office Action dated March 13, 2006, has been received and reviewed.

Claims 1-24 are currently pending and under consideration in the above-referenced application. Each of claims 1-6, 9-11, 14-16, 19-21, and 24 stands rejected. Claims 7, 8, 12, 13, 17, 18, 22, and 23 have been withdrawn from consideration.

Reconsideration of the above-referenced application is respectfully requested.

Objection to the Drawings

The drawings have been objected to under 37 C.F.R. § 1.83(a), for not showing every feature of the invention specified in the claims.

It has been asserted that “an alignment device with at least one receptacle formed therein; and at least one semiconductor device assembly including a mounting element with a receptacle as recited in claim 1 and [a] receptacle of the mounting element[,] as recited in claim 9,” are not shown in the drawings.

An example of an alignment device 40 with at least one receptacle 41, is shown in at least Figs. 7, 8, 10a, 10b, 11a, and 11b. An example of a mounting element 13 with a receptacle 17, is shown in at least Figs. 3 and 4. As the drawings provide an example of every feature recited in the claims, withdrawal of the 37 C.F.R. § 1.83(a) objections to the drawings is respectfully solicited.

Rejections under 35 U.S.C. § 112

Claims 1-6 and 9 stand rejected under 35 U.S.C. § 112, second paragraph, for reciting subject matter that is allegedly indefinite.

It is respectfully submitted that one of ordinary skill in the art would readily understand from the plain language of independent claim 1 that each of the alignment device and the mounting element includes a receptacle. It is further submitted that it would be inappropriate to refer to these receptacles as first and second receptacles, as there is no requirement (or prohibition) that either the alignment device or mounting element include more than one receptacle, as the term second might infer. Moreover, it is submitted that the subsequent claims

clearly identify the particular receptacle to which subsequent reference is made. Therefore, it is respectfully submitted that claims 1-6 and 9 satisfy the definiteness requirement of 35 U.S.C. § 112, second paragraph and, thus, that each of these claims is in condition for allowance.

Withdrawal of the 35 U.S.C. § 112, second paragraph, rejections of claims 1-6 and 9 is respectfully solicited.

Rejections under 35 U.S.C. § 102

Claims 1-6, 10, 11, 14-16, and 19-21 stand rejected under 35 U.S.C. § 102.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single reference which qualifies as prior art under 35 U.S.C. § 102. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Smith

Claims 1-6, 10, and 11 have been rejected under 35 U.S.C. § 102(b) for being drawn to subject matter that is purportedly anticipated by the subject matter described in U.S. Patent 5,244,403 to Smith et al. (hereinafter “Smith”).

It is respectfully assert that independent claim 1 is not anticipated by Smith under 35 U.S.C. § 102(b) because Smith does not expressly or inherently describe each and every element of independent claim 1. In particular, Smith does not expressly or inherently describe “a mounting element with a receptacle configured to receive at least a portion of . . . at least one semiconductor device,” as recited in independent claim 1.

Rather, the description of Smith is limited to a memory module 70, or packaged semiconductor device, that includes openings 23, or holes, near the side edges thereof. *Smith*, column 3, lines 12-14. These openings 23, or holes, are configured “for cooperative engagement with” the fingers 24 of locking members 25 associated with a socket 10 that has been secured to a circuit board 80. *Id.*

Contrary to the assertion that has been made at page 4 of the Office Action of March 13, 2006, the openings 23, of holes, of the memory module of Smith do not receive an portion of a semiconductor device. Therefore, Smith does not anticipate this element of independent claim 1.

As such, it is respectfully submitted that, under 35 U.S.C. § 102(b), the subject matter to which independent claim 1 is drawn is allowable over the subject matter described in Smith.

Each of claims 2-6 is allowable, among other reasons, for depending either directly or indirectly from claim 1, which is allowable.

With respect to the subject matter recited in independent claim 10, as amended and presented herein, it is respectfully submitted that Smith does not expressly or inherently describe that at least a portion of at least one semiconductor device may be disposed in a receptacle of a mounting element. Again, no portion of the memory module 70 of Smith is disposed within the openings 23, or holes, of the memory module 70. Therefore, it is respectfully submitted that the subject matter recited in independent claim 10 is not anticipated by Smith and, thus, is allowable under 35 U.S.C. § 102(b).

Claim 11 is allowable, among other reasons, for depending directly from claim 10, which is allowable.

Perino

Claims 14-16 and 19-21 are rejected under 35 U.S.C. § 102(b) for reciting subject matter which is assertedly anticipated by the disclosure of U.S. Patent 6,007,357 to Perino et al. (hereinafter "Perino").

It is respectfully submitted that independent claim 14 is not anticipated by Perino under 35 U.S.C. § 102(b) because Perino does not expressly or inherently describe a semiconductor device package with a retainer including at least one receptacle configured to receive an edge of at least one semiconductor device.

While Perino describes a "[c]hip socket assembly 800" that includes a clip 430, 830 that "may be used to mechanically and electrically couple a chip 840 to a bus of a circuit board 902," (*Perino*, column 10, lines 42-44, by retaining a chip 840 in a base 810 (column 10, lines 47-50), Perino lacks any express or inherent description that such a clip 430, 830 actually includes a

receptacle that is configured to receive an edge of a semiconductor device. Therefore, it is respectfully submitted that, under 35 U.S.C. § 102(b), the subject matter recited in independent claim 14 is allowable over the subject matter described in Perino.

Each of claims 15, 16, and 19-21 is allowable, among other reasons, for depending either directly or indirectly from claim 14, which is allowable.

Withdrawal of the 35 U.S.C. § 102(b) rejections of claims 1-6, 10, 11, 14-16, and 19-21 is respectfully solicited, as is the allowance of each of these claims.

Rejections under 35 U.S.C. § 103(a)

Claim 24 stands rejected under 35 U.S.C. § 103(a) for being directed to subject matter that is allegedly unpatentable over teachings from Perino.

The standard for establishing and maintaining a rejection under 35 U.S.C. § 103(a) is set forth in M.P.E.P. § 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claim 24 is allowable, among other reasons, for depending directly from claim 14, which is allowable.

Additionally, it is respectfully submitted that a *prima facie* case of obviousness has not been established against claim 24 because Perino does not teach or suggest each and every element of independent claim 14. In particular, Perino does not teach or suggest that a semiconductor device could be secured to one of the clips 430, 830 disclosed therein with an adhesive material.

It is respectfully requested that the 35 U.S.C. § 103(a) rejection of claim 24 be withdrawn and that claim 24 be allowed.

Allowable Subject Matter

The indication that claim 9 is directed to allowable subject matter is noted with appreciation, but that claim has not been amended to independent form, as the claims from which it depends are also believed to be allowable.

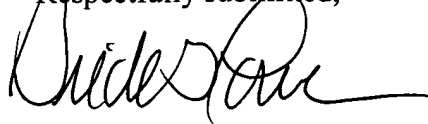
ELECTION OF SPECIES REQUIREMENT

It is respectfully submitted that independent claims 1, 10, and 14 remain generic to all of the species of invention that were identified in the Election of Species Requirement in the above-referenced application. In view of the allowability of these claims, claims 7, 8, 12, 13, 17, 18, 22, and 23, which have been withdrawn from consideration, should also be considered and allowed. M.P.E.P. § 806.04(d).

CONCLUSION

It is respectfully submitted that each of claims 1-24 is allowable. An early notice of the allowability of each of these claims is respectfully solicited, as is an indication that the above-referenced application has been passed for issuance. If any issues preventing allowance of the above-referenced application remain which might be resolved by way of a telephone conference, the Office is kindly invited to contact the undersigned attorney.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Brick G. Power", written over the typed name.

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